

REMARKS/ARGUMENTS

Claims 17-35 remain pending in the instant application. Favorable reconsideration is kindly requested.

Interview Summary

Applicants gratefully acknowledge the courtesy of Examiner Klayman and Supervisory Examiner Kim in granting a telephone interview with Applicants representative, held Tuesday, November 9, 2010. A summary of that interview is filed concurrently herewith.

Rejection under 35 U.S.C. § 103

Claims 17-20, 22 and 25 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,795,210 to Kushner, *et al.* ("Kushner") taken alone. Applicant respectfully traverses the rejection, for at least the following reasons.

Independent claim 17 recites a toy building block comprising, *inter alia*, at least one stud with a plurality of circumferentially arranged, substantially equally spaced teeth with rounded crests and interspersed rounded grooves, and a bottom surface of the block having at least one recess with sidewalls, at least one sidewall of the recess having a substantially vertically extending land shaped complementary to and extending into a respective one of the rounded grooves of the stud. The Office Action avers that this feature is taught by Kushner. Applicant respectfully disagrees.

The Office Action cites to the bar-shaped "projecting intermediate members 31" of Kushner, or alternately their intersection with the "cylindrical projections 10", as corresponding to the recited rounded grooves in the stud. The Office Action specifically points to this region in its annotated figure at Page 5. On the other hand, the Office Action cites to "coupling positions 21 and 41" as reading on the lands recited in claim 17. However, the cylindrical tube 20 of Kushner, or any portion thereof, including coupling positions 21 and 41, engages an exterior portion of the combined 'stud' as this features is read onto Kushner. See, for example, Fig. 5 of Kushner, where the tube 20, is seated entirely within the combination of projections 10 and 31. It is apparent that no portion of the tube 20 falls within the outwardly facing area between studs 10 and adjacent projection 31 which the Office Action defines as the "rounded grooves" according to claim 17. Kushner therefore does not meet this feature of claim 17.

Additionally, the cited projections (21, 41) of Kushner alleged to correspond to the lands of claim 17 are, as acknowledged in the Office Action, on the central tube in the recess. They are not, as recited in claim 17, on a sidewall of the recess. Therefore, Kushner lacks these expressly recited features of claim 17, and accordingly the claim is submitted as patentably distinguished.

The fact that Kushner lacks a land extending into the rounded grooves of the stud is applicable with equal force where claim 17 as previously presented recited

the recesses are shaped such that one of the studs inserted
in one of the recesses is guided by at least three zones of contact,
and at least one of the zones is a land in the recess of another of the
blocks engageable in a groove in the stud.

In discussion on this point during the aforementioned interview, the Examiner's position was that "engageable in a groove of the stud" was insufficient to specifically refer to the rounded grooves as earlier recited. It was therefore agreed that an amendment to the effect of "engageable in a groove-one of the rounded grooves in the stud" (markup per 37 C.F.R. § 1.121) patentably distinguished the claim. However, the Examiner's position as applied to the final paragraph of claim 17 would not be applicable to its preceding paragraph, which had already and specifically recited "one of the rounded grooves". Without prejudice to the argument, and in accordance with the agreement reached in the telephone interview, claim 17 is further amended above as indicated. In light of these remarks and amendments, and as agreed in the interview, Applicant respectfully submits that the claim is thus patentably distinguished over Kushner.

This amendment is made solely to advance prosecution and does not acquiesce in the other deficiencies in the rejection of independent claim 17. Among these, the rejection of claim 17 is premised on the presumption (*e.g.*, annotation, Page 5) that space either adjacent the projection 31, or at the intersection of projection 31 with stud 10, constitutes a "rounded groove". Applicant respectfully disagrees. The portions cited in the Office Action are either a flat bar 31, or alternately a sharp corner intersection, neither of which can be considered "rounded" in any reasonable sense of the term, and particularly not as recited in independent claim 17. Notwithstanding the Examiner's offer in the interview to "agree to disagree", as well-intentioned as it may have been, such an offer cannot transform what the references disclose as straight with a sharp corner into something "rounded" as recited in the claim. It is well established that "claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the

specification in giving them their broadest *reasonable* interpretation." *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir., 1983) (emphasis in original) (internal quotes and citation omitted).

Moreover, to consider what is straight, or has a sharp intersection to be "rounded" is to consider that the term "rounded" as used in the claim has no substantive meaning, and to effectively read it out of the claim. The courts have prohibited such unreasonable interpretations and manipulations of claim language as well. *See, In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) (The Office may not properly dissect a claim, excise subject matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

Furthermore, claim 17 recites that "the stud having a height extending above the top surface of the block by at least about 30% of the height of the block". The Office Action acknowledges, that this feature is neither taught nor suggested in Kushner. However, the Office Action then concludes, without any support from the prior art, that it would have been obvious to modify the height of the projections (10, 31) in Kushner to achieve this feature of claim 17. Applicant respectfully disagrees.

Kushner gives one of ordinary skill in the art no hint that substantially increasing the height of the projections 10, 31, has any substantive impact on the interlocking of the blocks. Optimizing a variable within a known range is only obvious where the prior art teaches that the variable in question is result-effective. *In re Boesch*, 617 F.2d 272 (CCPA 1980). *See also*, M.P.E.P. § 2144.05(II)(B), 8th Ed., Rev. 6 (Sept. 2007). That is not the case here. The Office Action points to no teaching or suggestion in Kushner (nor elsewhere) that the height of the projections is a known result-effective variable. Therefore, the Office Action sets forth no apparent reason for one of ordinary skill in the art to seek to alter the height of the projections 10, 31 in Kushner to achieve the values of stud height recited in claim 17. It is not an "optimization" of Kushner as suggested in the Office Action, there being no apparent benefit to be gained by such "optimization". Here again, the Examiner's well-intentioned offer in the telephone interview to "agree to disagree" on this point cannot overrule controlling Federal Circuit precedent contrary to the Examiner's position. An obviousness rejection based solely upon

hindsight reconstruction remains impermissible. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 421 (2007)¹.

For any of the foregoing reasons, Applicant respectfully submits that independent claim 17 is patentably distinguished over Kushner. Claims 18-20, 22 and 25 each depend, either directly or indirectly, from independent claim 17. These dependent claims are each separately patentable, but in the interest of brevity, they are offered as patentable for at least the same reasons as their underlying independent base claim, the features of which are incorporated by reference. Therefore, Applicant respectfully submits that the rejection has been overcome, and kindly requests favorable reconsideration and withdrawal.

Claim 21 is rejected under 35 U.S.C. §103(a) as obvious over Kushner as applied to claim 17, and further in view of U.S. Patent No. 3,487,579 to Brettingen ("Brettingen") and U.S. Patent No. 4,582,495 to Orgrass, *et al.* ("Orgrass"). Applicant respectfully traverses the rejection, for at least the following reasons.

The Office Action cites to Brettingen and/or Orgrass as having 6-, 8- or 12-fold rotational symmetry, and therefore comes to the conclusion that it would have been obvious to modify Kushner to have 6-, 8-, or 12- fold rotational symmetry. Applicant respectfully disagrees.

The underlying Kushner reference discloses a square block with, at most, 4-fold rotational symmetry. As illustrated in Fig. 5 of Kushner, the block is held against rotation once engaged by the interaction of the vertical side walls 2 with the cylindrical projections 10. More specifically, two adjacent side walls 2 at right angles to one another act on the projection 10, which are roughly at the extreme corners of the block, to hold the block against rotation. If one of ordinary skill in the art wished to, as the Office Action proposes, modify an entire block to include additional multiples of rotational symmetry, for example a hexagonal form as in Brettingen, the included angles between the adjacent walls would increase from a 90-degree right angle to a 120-degree reflex angle. This flattening of the included angle would decrease the hold the sidewalls 2 have on the projections 10, and thus decrease the rotational stability of a two-block unit. Going further to octagonal for 8-fold symmetry or dodecagonal for 12-fold symmetry increases the included angle between adjacent walls to 135 degrees and 150 degrees,

¹ "...[I]n order to determine whether there was an apparent reason to combine the known elements in the fashion claimed To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ("[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there

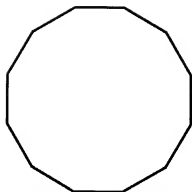


Figure 1 - 12-Sided Dodecagon

respectively. A dodecagon is nearly circular, and would exhibit little to no rotational hold on the studs 10. Therefore, one of ordinary skill in the art would be motivated away from the proposed modification to decrease the rotational stability of the building block proposed in the Office Action. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

Considering on the other hand, the stud as disclosed in Orgrass, a similar deficiency inures to the proposed combination. By modifying the stud to be more circle-like as in Orgrass, the base reference to Kushner becomes less resistant to rotational forces. The interaction between the projection 10 and the sidewall 2 is moved away from the corners of the block towards the centers of the sidewall 2. The angle of interface between the sidewall 2 and the projection 10 is thus made nearly oblique, as to virtually eliminate any rotational resistance between the blocks. One of ordinary skill in the art would be motivated away from such a modification that would undermine an important function of the block. "If when combined, the references 'would produce a seemingly inoperative device,' then they teach away from their combination." *Tec Air Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

Therefore, Applicant respectfully submits that one of ordinary skill in the art would be motivated away from combining the references as proposed in the Office Action, and that the rejection of dependent claim 21 is poorly taken. Favorable reconsideration and withdrawal of the rejection is kindly requested.

Claims 23 and 24 are rejected under 35 U.S.C. §103(a) as obvious over Kushner in view of U.S. Patent No. 6,088,987 to Simmons, *et al.* ("Simmons"). Applicant respectfully traverses the rejection.

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")." *Id.*

Simmons is directed to a system of modular building materials. The Office Action cites to certain features of the full-size building materials, and avers that it would have been obvious to incorporate these into a toy block such as Kushner. In support of this, the Office Action cites to disclosure in Simmons that the various sizes and shapes of building block may be simulated in plastic miniature scale model (Col. 6, lines 15-25).

However, the scale model disclosed in Simmons is indicated to be temporarily constructed for planning purposes only. The blocks used for this purpose would therefore not be expected to include each and every feature of their full-size counterpart. Specifically where, as in this case, the features of the full-sized block that are relied upon are specifically concerned with the permanent joining of full-size concrete construction blocks. Such features would not be present in the toy miniatures, which are made of plastic and held by friction.

Therefore, Applicant respectfully submits that the proposed combination of Kushner and Simmons is also poorly taken, and kindly requests favorable reconsideration and withdrawal.

Claim 26 is rejected under 35 U.S.C. §103(a) as obvious over Kushner as applied to claim 17 and further in view of U.S. Patent No. 5,471,808 to De Pieri, *et al.* ("De Pieri"). Applicant respectfully traverses the rejection.

Claim 26 as previously presented recited "slots across the lateral outer face" of the toy building block. The Office Action cited to De Pieri, and particularly Fig. 3, as allegedly teaching this feature. Applicant respectfully disagrees.

The cited portion of De Pieri discloses that a framework 23, and particularly legs 26, are received in seats 24. The Office Action cites these seats 24 as slots recited in claim 26, and further alleges that these go across the lateral side face of the block. However, even presuming that seats 24 may be considered slots, they are not "across" the lateral face as recited in the claim. The seats 24 of De Pieri are exclusively at the perimeter of the side face. They encircle the lateral face, and define its extents, but they do not enter into the face itself, that is they are not "across" the face.

Without acquiescing to the point, consistent with the agreement reached in the telephone interview, claim 26 is amended above to recite "~~slots across~~ at least one slot penetrating the lateral outer face" (markup per 37 C.F.R. § 1.121). No new matter has been added. Referring then to De Pieri, the seat 24 does not penetrate the lateral side face, but merely encircles and defines it. As agreed in the telephone interview, Applicant respectfully submits that the claim as

Claim 27 is rejected under 35 U.S.C. §103(a) as obvious over Kushner as applied to claim 17 and further in view of U.S. Patent No. 6,506,091 to Garpow (“Garpow”). Applicant respectfully traverses the rejection, for at least the following reasons.

Claim 27 is amended above to recite “the block comprises a bivalent building block having at least one of the recesses on ~~at least one of the~~ top surface and the bottom surface” (markup per 37 C.F.R. § 1.121). The claim had always referred to “at least one of the recesses”, invoking the underlying features of claim 17. As clarified, the amended claim recites the block includes a recess having the same features on its top and bottom surface.

By contrast, Garpow does not teach or suggest that a block includes recess having the same features on both a top and bottom surfaces. Rather, at most Garpow discloses a block having a removable stud 40 that screws into the block 20, and that the hollow interior of the block 20 can be accessed through the threaded opening 47. On the other hand, an underside of the block includes recesses 70, 80, 90. There is no teaching or suggestion in Garpow that opposite sides of the block includes like recesses that are operative to receive a stud in either of them.

Therefore, in light of the amendment and the foregoing remarks, and consistent with the agreement reached in the telephone interview, Applicant respectfully submits that claim 27 is patentably distinguished over Kushner and/or Garpow, singly or in combination. Favorable reconsideration and withdrawal of the rejection is kindly requested.

Claims 28-30 are rejected under 35 U.S.C. §103(a) as obvious over Kushner in view of Simmons as applied to claim 23 and further in view of U.S. Patent No. 2,609,638 to Lindenmeyer (“Lindenmeyer”). Claim 31 is rejected under 35 U.S.C. §103(a) as obvious over Kushner in view of Simmons and Lindenmeyer as applied to claim 28, and further in view of U.S. Patent No. 5,498,188 to Deahr (“Deahr”). Claims 32 and 33 are rejected under 35 U.S.C. §103(a) as obvious over Kushner in view of Simmons as applied to claim 23 and further in view of Garpow. Claims 34 and 35 are rejected under 35 U.S.C. §103(a) as obvious over Kushner in view of Simmons and Lindenmeyer as applied to claim 28, and further in view of Garpow. Applicant respectfully traverses the rejection for at least the following reasons.

Each of claims 28-35 depends, either directly or indirectly, from claim 17 though claim 23, and incorporates by reference the features of their underlying base claims. Without prejudice to the deficiencies of Garpow addressed above and overcome by amendment to claim 27, the

proposed addition of Lindenmeyer, Deahr, and/or Garpow offers no teaching or suggestion to ameliorate the underlying deficiencies of Kushner with respect to claim 17, nor Kushner and Simmons with respect to claim 23, both of which are discussed above. Therefore, while claims 28-35 are each separately patentable, there are respectfully submitted as patentable for at least the same reasons as their underlying base claims 17 and 23. Applicant respectfully submits that the rejection has been overcome, and kindly requests favorable reconsideration and withdrawal.

Conclusion

In light of the foregoing, Applicant respectfully submits that all claims are patentable, and kindly solicits an early and favorable Notice of Allowability.

THIS CORRESPONDENCE IS BEING
SUBMITTED ELECTRONICALLY
THROUGH THE PATENT AND
TRADEMARK OFFICE EFS FILING
SYSTEM ON November 15, 2010.

RCF/DJT:lf

Respectfully submitted,



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